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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,391	02/15/2001	Kevin C. Jones	EWG-076	3000

23735 7590 09/20/2006

DIGIMARC CORPORATION  
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EXAMINER

PATEL, SHEFALI D

ART UNIT PAPER NUMBER

2624

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/784,391	<b>Applicant(s)</b> JONES, KEVIN C.	
	<b>Examiner</b> Shefali D. Patel	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☒ Claim(s) 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 11, 2004 has been entered.

### *Response to Amendment*

2. The amendment was received on August 9, 2004.

### *Response to Arguments*

3. Applicant's arguments, see Remarks on pages 6-9, filed August 9, 2004, with respect to claims 1-12 have been fully considered and are persuasive. The rejection has been withdrawn.
4. Applicant's arguments with respect to claims 13-16 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsikas (US 6,868,498) in view of Zhao et al. (hereinafter, "Zhao") (US 6,141,753).

With regard to **claim 13** Katsikas discloses a method of transmitting electronic messages from a sender to a receiver (Figure 1A) comprising, detecting and reading *digital watermarks* carried in such messages to determine information carried in the *watermarks* (col. 3 lines 59-62), interrogating a database

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to determine what action should be taken with a message based at least in part upon the information in the *watermark* (ASL as a database at col. 4 lines 42-54). Katsikas does not expressly disclose the information being watermarks. Zhao discloses documents (i.e., messages) having a watermark embedded in for distributing purpose at col. 6 line 33 (specifically at col. 4 lines 13-18, 27-43 and col. 6 lines 33-67). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Zhao with Katsikas. The motivation for doing so is to determine whether the user can access the desired digital representation (i.e., messages) at all, and if the user can, whether the use type is specified by the user is one that is permitted for the user as suggested by Zhao at col. 6 lines 50-54. Please note Katsikas discloses employing "certain predefined rules" at col. 4 line 48 which is the rule from Zhao whether the user have access to the digital representation or not depending on the watermarked public or private key. Therefore, it would have been obvious to combine Zhao with Katsikas to obtain the invention as specified in claim 13.

With regard to **claim 14** Zhao discloses detecting and reading of digital watermarks performed in a server separate from a source and destination of the messages as seen at Figure 1 and the respective portions in the specification for the Copy Server 103(j) and Copy Client 119(i).

With regard to **claims 15-16** Zhao discloses documents in and attached to the messages are passed to a watermark detecting process (WOR 121) for detecting watermarks in the documents in and attached to the messages (watermark reader 109 and 123).

***Allowable Subject Matter***

7. Claims 1-12 are allowed.

The closest prior art to Thorne and Rhoads are directed to electronic messaging system as disclosed in independent claims 1, 2, 3, 5 and 10 (as discussed in the previous office action).

However, the closest prior art fails to disclose anything about an electronic messaging system including a mail server which sends and receives messages, said mail server including a watermark

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reading program that reads watermarks in said messages, the program operable to read watermarks in documents that form at least part of the messages and operable to read watermarks in documents attached to the messages, and the program operable to control distribution of said messages in response to data in said watermarks as disclosed in claims 1, 3 and 5. Further, the closest prior art fails to disclose a system that includes an e-mail server connected to the Internet, the system comprising means for transmitting messages from an individual user to said e-mail server, watermark detecting means for detecting and reading watermarks in e-mail messages at the server after the messages are sent from the user but before such messages are transmitted from said e-mail server to the Internet, means for preventing the transmission of messages from said e-mail server to the Internet if said watermark detecting means detects a watermark which has an indication that the message including said watermark is confidential as disclosed in claim 2. The closest prior art also fails to disclose a method of transmitting electronic messages from a sender to a receiver which comprises, detecting and reading digital watermarks carried in such messages to determine how flags in such watermarks are set, interrogating a database to determine what action should be taken with a message based upon the identity of the sender, the identity of the receiver and the flag settings in the watermark in the messages as disclosed in claim 10. It is for these reasons in combination with all the other elements of the claim that claims 1, 2, 3, 5, and 10 would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims. Dependent claims 4, 6-9 and 11-12 are allowable for the same reasons.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 7,000,186 – Method and structure for electronically transmitting a text document and linked information, col. 3-4.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D. Patel whose telephone number is 571-272-7396. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on (571) 272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

sdp

JINGGE WU  
PRIMARY EXAMINER

Shefali D Patel  
Examiner  
Art Unit 2624